

REMARKS

The application has been amended to place the application in condition for allowance at the time of the next Official Action.

A verified English translation of Japanese priority document JP 2000-031348 filed February 9, 2000 is forthcoming and will be submitted as soon as it is received from the applicant.

Claims 1, 3, 5-10, 12-14, 16 and 17 are pending in the application.

Claims 1, 10 and 14 are amended to clarify the difference between the recited "contents" so as to distinguish between "contents supported by said terminal device", "contents obtained from said server device", "converted contents" and "converted image contents". The above changes are believed to address the 35 USC §112, second paragraph rejection as to claims 1, 10 and 14.

As to claims 7, 8, 12 and 16, there is only one recited "constraint information". Claim 1 recites that the storage unit stores constraint information peculiar to the terminal device. Reference to "said constraint information" further recited in claim 1 refers back to the same constraint information initially recited. The same holds true for the recited "said constraint information" in claims 7 and 8.

The analysis above regarding claim 1 is equally applicable to independent claims 10 and 14. Accordingly, the

rejection under 35 USC §112, second paragraph, as to claims 7, 8, 12 and 16 is believed addressed. By the present amendment and the foregoing remarks, it is believed that the 35 USC §112, second paragraph rejections have been overcome and should be withdrawn.

Claims 1, 3, 5-10, 12-14, 16 and 17 are rejected as unpatentable over ADAMS et al. 6,457,030 in view of FLETCHER et al. 6,138,156. This rejection is respectfully traversed.

The position set forth in the Official Action is that ADAMS does not teach the verification steps for conversion. FLETCHER is offered for the teaching of converting content when possible. The motivation for combining the references is that it would be obvious to one of ordinary skill in the art to determine whether conversion of contents is possible along with other verification steps for conversion before the determination of conversion in order to facilitate determining whether conversion is necessary.

However, the above-noted motivation for combining the references is believed insufficient for at least the following reasons.

The Court of Customs and Patent Appeals has held: "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not

sufficient to render the claims *prima facie* obvious." *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Column 8, lines 34-38 of ADAMS teaches making a decision whether and/or how to display elements based upon assigned priorities. For example, based on a low priority, an element may be reformatted or ignored altogether based on limited display characteristics or limited bandwidth.

Accordingly, ADAMS sets a priority of elements regardless of size of the file and then displays an element at a pervasive computing device based on the priority assigned to the element.

FLETCHER uses a rule-based approach to select an appropriate filter enabling varying types and degrees of content reduction to be applied based on currently existing conditions. This manages the volume of data received by the user, without requiring input from the user by reducing the amount of data sent to the user by a server.

Accordingly, the systems of ADAMS and FLETCHER are based on two completely different systems. ADAMS requires user input to set priorities for files that will be received and FLETCHER sends files based on currently existing conditions without user input.

Modifying ADAMS in view of FLETCHER would entail receiving information based on currently existing conditions, regardless of priority. Since ADAMS is a priority-based system,

modifying ADAMS in the manner suggested would change the principle of operation of ADAMS such that the proposed combination of references is not sufficient to render the claims *prima facie* obvious.

Moreover, the device of ADAMS is a pervasive computing device as described on column 2, lines 20-25 as a handheld type device. The work station 10 of FLETCHER is a personal computer having different requirements than a handheld device. One of ordinary skill in the computing art taking into account the limitations of a handheld device would not be motivated to use the software programming code of FLETCHER that uses a large amount of memory and is stored in a hard drive of a personal computer for use with the handheld device of ADAMS.

Accordingly, at least for the reasons set forth above, there is believed no motivation to combine the references in the manner suggested.

In view of the present amendment and the foregoing remarks, it is believed that the present application has been placed in condition for allowance. Reconsideration and allowance are respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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